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09/538,792	03/30/2000	Vincenzo Scotto Di Carlo	GR 97 P 2659	7892

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LERNER GREENBERG STEMER LLP
P O BOX 2480
HOLLYWOOD, FL 33022-2480

EXAMINER

PHAN, JOSEPH T

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2614

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/538,792
Filing Date: March 30, 2000
Appellant(s): DI CARLO ET AL.

MAILED

JUL 24 2006

Technology Center 2600

Werner H. Stermer
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the Order Returning Undocketed Appeal to the examiner from BPAI filed 04/19/2006 and the appeal brief filed 07/20/05. The examiner is providing a new grounds of rejection to an inadvertent numbering omission of claims 13 and 14 as detailed in the examiners grounds of rejection.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUNDS OF REJECTION below for dependent claims 13 and 14.

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Appellant's brief presents arguments relating to whether the term "new" raises new issues. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,333,973

Smith et al.

12-2001

(9) Grounds of Rejection

NEW GROUNDS OF REJECTION

Examiner provides a new ground of rejection below for claims 13 and 14.

It is noted that the numbering claims of 13 and 14 were inadvertently omitted from the prior action. This new ground of rejection is provided to correct a numbering formality which is insignificant to appellant's arguments and grounds of rejection to be reviewed. The prior action cited that claims 1-12 are rejected by Smith but should have recited 1-14 as the metes and bounds of claims 13 and 14 were interpreted onto the limitations of claim 1.

In particular, Claim 13 recites "...*transmitting only a notification to the at least one previously selected terminated*". Claim 14 recites "...*transmitting a notification only indicating that a new message is present and in which message service the new message is present*". Claims 13 and 14 merely adds the term 'only' to the transmitting step which does not further limit the step. The term 'only' does not indicate boundaries and therefore is interpreted similar to the term "at least". The claims only require that '*...the notifications are transmitted...*' which Smith discloses.

In view of the above, this new ground of rejection should be moot and further because appellant did not argue the merits of the art rejection, only argues the validity

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of the Smith reference in view of appellant's 1.131 declaration to overcome Smith's priority date.

The following ground(s) of rejection are applicable to the appealed claims:

I. **Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al., Patent #6,333,973.**

Regarding claims 1 and 13-14, Smith teaches a method of notifying a subscriber of a plurality of message services of a message, which comprises:

indicating, with each of the plurality of message services, to a common notification server a presence of a new message for a subscriber on the respective message service(Fig.7A/7B and col.3 lines 50-54);

selecting, by the subscriber, at least one terminal from a plurality of terminals of the message services (*Fig.7A/7B, Fig.11; a plurality of terminals of messages services is shown on the phone*);

transmitting a notification, with the notification server, to the least one selected terminal, in contrast to transmitting the message, the transmitted notification indicating that a new message is present and in which message service the new message is present (*Fig.10 and Fig.11, col.4 lines 1-3 and col.8 lines 40-45; a notification message is sent to a terminal selected by the subscriber*).

Regarding claim 2, Smith teaches the method according to claim 1, which comprises, if a message service indicates the presence of a new message, storing with the notification server the data originating from the message service, until the respective notification has been transmitted successfully(col.4 lines 50-56).

Regarding claim 3, Smith teaches the method according to claim 1, wherein the transmitting step comprises transmitting with the notification server the notification to all terminals of the subscriber(col.3 lines 50-54).

Regarding claim 4, Smith teaches the method according to claim 1, wherein the transmitting step comprises transmitting with the notification server the notification to at least one terminal selected by the subscriber from a plurality of terminals (col.10 lines 30-37).

Regarding claim 5, Smith teaches the method according to claim 4, wherein the subscriber selects the terminal by transmitting a control information item from the respective terminal to the notification server (col.10 lines 30-37).

Regarding claim 6, Smith teaches the method according to claim 1, which comprises transmitting with each message service a message header information item to the notification server when a new message is present, and transmitting the message header information with the notification server at least partially to the at least one terminal selected, at least partially, to output the message header information (col.8 lines 36-45).

Regarding claim 7, Smith teaches the method according to claim 1, which comprises, in response to a request by the notification server, transmitting with each message service a message header information item to the notification server, and transmitting at least partially the message header information item with the notification server to the at least one terminal selected to output the message header information(col.8 lines 36-45).

Regarding claim 8, Smith teaches the method according to claim 1, which comprises, in response to a subscriber request from any terminal, firstly performing an authorization check with the notification server and then transmitting the notifications present to the terminal (col.10 lines 8-15 and lines 50-56).

Regarding claim 9, Smith teaches the method according to claim 1, which comprises processing with the notification server the data originating from the message services for generating the notifications transmitted to the subscriber(col.10 lines 5-10 and 18-25).

Regarding claim 10, Smith teaches the method according to claim 9, wherein the processing step comprises selecting one or more processes from the group consisting filtering, ordering, and formatting the data (col.10 lines 48-56; by pressing the "view" button, Smith filters, orders, and formats the data).

Regarding claim 11, Smith teaches the method according to claim 1, wherein the transmitting step comprises transmitting the notifications by means of a signaling operation to the at least one terminal of the subscriber (Fig.1-the signaling path from label 11 through 1800 to 1200).

Regarding claim 12, Smith teaches the method according to claim 1, wherein the transmitting step comprises transmitting the notifications by means of a call set-up to the at least one terminal of the subscriber (1300 Fig.1 and col.4 lines 15-24).

II. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 line 2 recites "a message", line 4 recites "a new message", line 10 recites "the message", line 11 recites "a new message", and line 12 recites "the new message". It is unclear and indefinite if these messages are referring to the same message or are different messages. The specification on page 9 discloses several different types of messages (e.g.

text messages, voice messages, SMS messages, and email messages), therefore the lack of antecedent basis, specifically for “the message” in line 10 and “a new message” in line 11 makes the claim unclear as this could be read as a different new message. Examiner interprets all of the recited messages as one same new message and the notification in line 8 as a notification message transmitted before the new message.

(10) Response to Argument

I. Appellant argues that the Smith patent, #6,333,973, filed 04/23/1997 cited above is not available as prior art against the present claims in view of appellant’s submittal of declaration 37 CFR 1.131 dated 04/24/1997. Examiner respectfully disagrees as the declaration has been considered but is ineffective to overcome the Smith patent.

Appellant has failed to prove conception or reduction to practice of the invention Prior to the effective date of the Smith reference. The evidence submitted by appellant which is written as a ‘patent proposal’ is dated 04/24/1997, a day After the effective date of the Smith reference. Furthermore, merely alleging that conception and reduction to practice occurred before the Smith reference is not sufficient. At a minimum, MPEP requires there must be evidence that proves at least conception of the claimed invention Prior to the Smith patent coupled with due diligence from prior to the reference date.

As outlined in the MPEP section 715.07 [R-2], 37 CFR 1.131(b) states:

III. THREE WAYS TO SHOW PRIOR INVENTION

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show

conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

(A) reduction to practice of the invention prior to the effective date of the reference; or

(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or

(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to

another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. Automatic Weighing Mach. Co. v. Pneumatic Scale Corp., 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909).

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. See MPEP § 2138.04 through § 2138.06 for a detailed discussion of the concepts of conception, reasonable diligence, and reduction to practice.

In view of the patent laws above, the evidence submitted After the effective date of the Smith patent and a mere statement by Appellant and Inventors that conception and reduction to practice occurred before 04/23/1997 is insufficient.

It is also noted that appellant contradicts his statements on page 20-21 of the brief. Stating on one hand, that both inventors have sworn, in the declaration of November 2002, that *"the present invention was reduced to practice prior to April 23, 1997"*, the filing date of the Smith patent and on the other, appellant states at the top of page 21, that *"diligence is shown by filing of a patent application(German) on the disclosed invention only about five months after the Invention Disclosure was signed...."* Here, Appellant admits diligence is shown After the proposed invention disclosure, dated April 24, 1997, which allegedly was already reduced to practice by the inventors. Therefore one would assume the invention disclosure, if already reduced to practice, would incorporate language or evidence of a system that was operational and running, rather the invention disclosure incorporates a proposal of how the system should and

may operate(see the term "may" used throughout the proposal pages 3-4).

It is also noted that appellant has not complied with the requirements of 35 U.S.C. 371 to claim priority over the German application filed 09/30/1997 to achieve at least an effective priority date of 09/30/1997 since a certified copy of the German application has not been received by the Patent Office nor a certified translation thereof which was requested in examiner's first office action.

In response to appellant's argument of whether the Smith patent, that was cited in the first non-final action, can be revived and cited again in later actions if it is sworn behind by a 37 CFR 1.131 declaration. In response, It is noted that examiner did not agree nor approve of the 1.131 declaration for it to be sworn behind the Smith patent. The absence of acknowledgement of the affidavit in the corresponding office actions is not proof that the 1.131 declaration was sufficient to overcome the Smith patent. Rather, the 1.131 declaration was overlooked because there was an amendment to the claims submitted by the appellant 1.5 months prior to submitting of the 1.131 declaration in which the examiner had already found and used another reference, Picard, which was applied because of amendments to the claims and not because of the 1.131 declaration.

In summary, because the claims were amended and the examiner never stated nor agreed that the 1.131 affidavit was sufficient to overcome Smith, the examiner is justified in using an earlier applied reference(i.e. Smith patent) in a later office action.

II. This issue of whether or not the addition of the word "new" into claim 1 raises new

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issues relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

III. In response to whether or not claim 1 is indefinite under 35 USC 112, second paragraph. Examiner's 112 2nd paragraph rejection is copied below.

Claim 1 line 2 recites "a message", line 4 recites "a new message", line 10 recites "the message", line 11 recites "a new message", and line 12 recites "the new message". It is unclear and indefinite if these messages are referring to the same message or are different messages. The specification on page 9 discloses several different types of messages (*e.g. text messages, voice messages, SMS messages, and email messages*), therefore the lack of antecedent basis, specifically for "the message" in line 10 and "a new message" in line 11 makes the claim unclear as this could be read as a different new message. Examiner interprets all of the recited messages as one same new message and the notification in line 8 as a notification message transmitted before the new message.

Since the primary focus of the invention is notification messages and notification of messages, the antecedent basis' of the "message(s)" are critical to the interpretation of the metes and bounds of the claims. It is merely not known if the claim is limited to only one new message or if it is broad enough to claim another new message. In view of this, the 112 2nd paragraph rejection of claim 1 should be maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Joseph T Phan

**A Technology Center Director or designee must personally approve the
new ground(s) of rejection set forth in section (9) above by signing below:**

Conferees:

Joseph T Phan

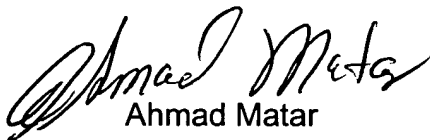
Patent Examiner


TOMMY P. CHIN
QUALITY ASSURANCE SPECIALIST

Fan Tsang

Supervisory Patent Examiner

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600


Ahmad Matar

Supervisory Patent Examiner